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Total Number of Pages in This Submission

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Application Number	10/698,924
Filing Date	October 31, 2003
First Named Inventor	Reddy et al.
Art Unit	1626
Examiner Name	Taofiq A. Solola
Attorney Docket Number	45198.00047.UTL

ENCLOSURES (Check all that apply)

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Remarks

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name Paul, Hastings, Janofsky & Walker LLP

Signature

Printed name Diana L. Bush, Ph.D., Esq.

Date April 29, 2005

Reg. No. 51,109

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Patent
45198.00047.UTL1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Reddy *et al.*

Serial No.: 10/698,924

Filed: October 31, 2003

Title: **NOVEL CYCLIC PHOSPHATE
DIESTERS OF 1,3-PROPANE-1-ARYL
DIOLS AND THEIR USE IN
PREPARING PRODRUGS**

Group Art Unit: 1626

Examiner: Solola, Taofiq A.

Customer Number: 36183

Mail Stop Amendment
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT

Dear Sir:

This communication is responsive to the Written Restriction Requirement mailed March 30, 2005. If any fee should become due or credit become payable during the pendency of this application, the Examiner is authorized to charge or credit the same to deposit account number 50-2613.

**CERTIFICATE OF MAILING
(37 C.F.R. §1.8a)**

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April 29, 2005
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Helen Lynn
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THE RESTRICTION REQUIREMENT

The Examiner has required restriction to one of the following Groups:

I. Claims 1-24, drawn to compounds of formulae (I), classified in several heterocyclic classes (540, 544, 544, 548, 546) and non-heterocyclic classes (558, 562, etc.), numerous subclasses.

II. Claims 25-54, drawn to a process of making compounds of formula (I), classified in several heterocyclic classes (549, 544, 544, 548, 546) and non-heterocyclic classes (558, 562, etc.), numerous subclasses.

III. Claims 78-96, drawn to process of making compounds of formula (V), classified in several heterocyclic classes (549, 544, 544, 548, 546) and non-heterocyclic classes (558, 562, etc.), numerous subclasses.

IV. Claims 55-77, 97-98, drawn to process of making compounds of formula (II), classes (549, 544, 544, 548, 546) and non-heterocyclic classes (558, 562, etc.), numerous subclasses.

Applicants hereby provisionally elect the invention of Group IV, with traverse. Applicants reserve their right to prosecute the non-elected subject matter in this application or in a divisional application. Applicants respectfully request reconsideration and withdrawal of the restriction requirement.

The Examiner contends that the

Markush group set forth in the claims includes both independent and distinct inventions, and patentably distinct compounds (or species) with each invention. However, this application discloses and claims a plurality of patentably distinct inventions far too numerous to list individually. Moreover, each of these inventions contains a plurality of patentably distinct compounds, also far too numerous to list individually. (Office Action p. 2)

The Examiner believes that "Inventions of groups II and I are related as process of making and product made respectively." (Office Action p. 5) The Examiner also contends that the "Invention of groups III-IV are not related to each other or any of the groups. They are different processes of making different compounds having different starting reagents. Therefore, the inventions are

independent and distinct, there is no patentable co-action among the various groups, and a reference anticipating on member will not render another obvious.” (Office Action p. 5) The Examiner also contends that “because of the plethora of classes and subclasses in each of the Groups, a serious burden is imposed on the examiner to perform a complete search of the defined areas.” (Office Action p. 5)

According to MPEP § 803, two criteria are required for proper restriction: 1) that the inventions be independent or distinct; and 2) that there be a serious burden on the examiner. The Applicants believe that the Examiner has not met either criteria.

The Applicants particularly do not understand the restriction between Groups III and IV. The Examiner contends that the “Invention of groups III-IV are not related to each other or any of the groups. They are different processes of making different compounds having different starting reagents.” Office Action p. 5. However, Formula V is within the scope of compounds of Formula II and Formula IV is within the scope of compounds of Formula I. Since compounds of Formula V and IV fall within the scope of compounds of Formulas II and I, there can be no undue burden on the Examiner to examine both groups together.

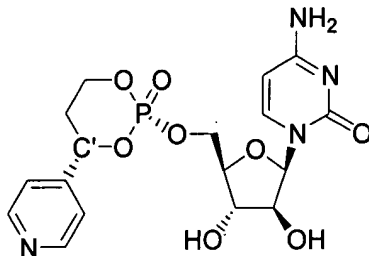
Furthermore, compounds of Formula I are included in each of Groups I, II, and IV. Formula IV from Group III is within the scope of compounds of Formula I. A search of Group IV will necessarily turn up art for all Groups.

THE ELECTION OF SPECIES REQUIREMENT

The Examiner further requires that the Applicants make an election of a single compound (or set of compounds):

including an exact definition of each substitution on the base molecule (Formula I), wherein a single member at each substituent group or moiety is selected...In the instant case, Applicant must elect one representative for each of L, V, in formula I, and the point of attachment of each elected substituent must be specified. Office Action p. 3

The Applicants hereby elect the following species for initial examination with traverse. For Formula I, L is Cl and V is 4-pyridyl. Formula II is a compound of the following structure:



Applicants understand that if the Examiner allows a generic claim, that the election of species will be withdrawn.

The claims from Group IV reading thereon are: Claims 55-77 and 97-98.

CONCLUSION

For the foregoing reasons, the Applicants respectfully request the Withdrawal of the Restriction Requirement and Election of Species Requirement.

Respectfully Submitted,

Date:

4/29/05

By:

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